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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,317	06/27/2003	Joseph Daniel Coenen	K-C 13485.1	7356
7590 11/16/2004 Pauley Petersen Kinne & Erickson Suite 365 2800 W. Higgins Road Hoffman Estates, IL 60195			EXAMINER PURVIS, SUE A	
			ART UNIT 1734	PAPER NUMBER

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/609,317

Applicant(s)

COENEN ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 22 is/are allowed.
- 6) ☒ Claim(s) 7-21, 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Instance (US Patent No. 5,674,334).

Instance discloses a process and apparatus for manufacturing labels where a continuously moving first layer (112) includes a plurality of pre-printed images which are equivalent to reference marks. A sensor (188) senses the reference marks and generates a signal thereby measuring the distance between the images. A plurality of continuously moving discrete components (122) are conveyed toward the first layer (112). Sensor (184) sends a signal to the pulse counter when a component (122) is detected in the feed system (126) thus sensing a distance between two successive components of the second layer. The sensor (188) operates in conjunction with a control system (not shown) to coordinate the application of the component (122) to the first layer (112) so that the component (122) coincide at the correct point on the web in registry with the printed image. Adhesive is applied to the upper surface of the web (112) by an adhesive applicator (186). The component sensor (184) or the web sensor (188) can be employed to trigger the application of adhesive to the web (112). (Figure 3; Col. 9, lines 1-31.)

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). (See MPEP §2115.) "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. (US Patent No. 5,818,719) in view of Instance.

Brandon discloses a process and apparatus for controlling the registration of two layers of material. The process includes providing a first layer (54) and a layer of discrete components (32). The feed of the discrete components is monitored by a proximity switch (62). The components are placed upon the first layer in a spaced apart manner. (Col. 9, lines 6-26). Figure 8 shows the waveform (156) of the proximity switch reading. (Col. 15, lines 53-61).

Brandon et al. does not the use of reference marks on the first layer and synchronizing the feed rate of the discrete components based on the reference marks.

Art Unit: 1734

Instead Brandon et al. uses a proximity switch for monitoring and controlling the placement of the components in relation to a second layer (66) which does have reference marks thereon. Adhesive is selectively applied to the second layer (66) by applicator (98). (Col. 11, lines 29-43).

Instance teaches that by using markers on a continuously moving web and components being properly placed thereon.

It would have been obvious to one having ordinary skill in the art at the time the invention was made that an additional means of control would be to add reference marks to the first layer as shown in Instance. This results in an additional means by which to control the placement of the components and insure proper placement and preventing mistakes in assembly. Instance teaches that such control is within the purview of one having ordinary skill in the art.

Regarding claim 13, in Brandon an additional layer (66), which is composed of two components (66, 92), is superimposed on the first layer and discrete components. An adhesive applicator (94) applies a desired pattern of a suitable adhesive to the continuously moving layer (92). (Figure 5.)

5. Claim 8 and 10-12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. in view of Instance as applied to claim 7 above, and further in view of Weyenberg (US Patent No. 5,359,525).

Brandon in view of Instance does not disclose determining the actual position of the components relative to the marks and correcting a setpoint of placement control for the components.

Weyenberg discloses an apparatus and method for registration control of assembled components. It includes a registration inspection apparatus (41) which communicates

comparator (61) wherein the actual position of the components is compared with the desired position. The inspection apparatus of the invention provides the requisite quality control. Weyenberg also discloses the step of determining the actual position of the superimposed components relative to the marks. (Col. 6, lines 24-36.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a sensing means located after the discrete component is added to the first layer in Brandon in view of Instance for quality control purposes, as disclosed in Weyenberg. In particular, by inspecting the actual position of the component on the web, there is an additional step for quality control besides using the sensor (188) to align the label to the web.

Regarding claims 10-12 and 18-20, Weyenberg determines the positional relationships and compares them to the desired positional relationships and signals representing the deviation of the actual positional relationship from the desired positional relationship. The deviation is used in a feedback control to adjust the operation of the respective component supply means in order to maintain the position of that component in each article within its acceptable range. (Col. 3, lines 30-40.)

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Instance as applied to claim 7 above, and further in view of Popp et al. (US Patent No. 5,932,039).

Brandon in view of Instance does not disclose filtering out signal anomalies.

Popp discloses in conjunction with performing a running average of the measured counts, a filtering function is performed to filter out signal anomalies. Examples of signal anomalies include a dirty photoeye, missing or extra reference marks (74), movement or weaving of the layers, measuring the counts outside a preprogrammed range for averaging

Art Unit: 1734

purposes, known inaccurate data due to registration control events, or the like. (Col. 16, lines 35-44.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a filtering step in Brandon in view of Instance, because Popp teaches is it useful filter out signals which may be caused by a dirty photoeye or sensor.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Instance as applied to claim 7 above.

While Brandon in view of Instance does not specifically show that the web layer is replaced, considering the layer supply is most likely finite, it is within the purview of the artisan to replace the supply as need. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the registration material on the web be different with different spacing as could be desired by the artisan.

8. Claims 15, 16, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al. in view of Instance and Weyenberg.

Brandon in view of Instance discussed in paragraph 4 above does not disclose the corrective step where the placement of components is corrected subsequent to superimposing the components on the first layer.

Weyenberg discloses an apparatus and method for registration control of assembled components. It includes a registration inspection apparatus (41) which communicates comparator (61) wherein the actual position of the components is compared with the desired position. The inspection apparatus of the invention provides the requisite quality control. (Col. 6, lines 24-36.)

Art Unit: 1734

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a sensing means located after the discrete component is added to the first layer in Brandon in view of Instance for quality control purposes, as disclosed in Weyenberg. In particular, by inspecting the actual position of the component on the web, there is an additional step for quality control besides using the sensor (188) to align the label to the web.

Regarding claim 16, the apparatus of Brandon in view of Instance and Weyenberg includes a step of correcting the placement of the labels onto the web, thus meets the limitation of these claims.

Regarding claims 18-20, Weyenberg determines the positional relationships and compares them to the desired positional relationships and signals representing the deviation of the actual positional relationship from the desired positional relationship. The deviation is used in a feedback control to adjust the operation of the respective component supply means in order to maintain the position of that component in each article within its acceptable range. (Col. 3, lines 30-40.)

Regarding claim 21, in Brandon an additional layer (66), which is composed of two components (66, 92), is superimposed on the first layer and discrete components. (Figure 5.)

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Instance and Weyenberg as applied to claim 15 above, and further in view of Popp et al.

Brandon in view of Instance and Weyenberg does not disclose filtering out signal anomalies.



Popp discloses in conjunction with performing a running average of the measured counts, a filtering function is performed to filter out signal anomalies. Examples of signal anomalies include a dirty photoeye, missing or extra reference marks (74), movement or weaving of the layers, measuring the counts outside a preprogrammed range for averaging purposes, known inaccurate data due to registration control events, or the like. (Col. 16, lines 35-44.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a filtering step in Brandon in view of Instance and Weyenberg, because Popp teaches is it useful filter out signals which may be caused by a dirty photoeye or sensor.

#### ***Allowable Subject Matter***

10. Claims 1-6 and 22 are allowed.
11. The following is an examiner's statement of reasons for allowance: Detailed in Office Action mailed on 30 June 2004.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Response to Arguments***

12. Applicant's arguments filed 30 August 2004 have been fully considered but they are not persuasive.
13. Regarding applicant's arguments with respect to claim 23, the addition of the group consisting of elastic ribbons etc. does not alter the rejection of the examiner, since that is

Art Unit: 1734

merely material worked upon in an apparatus. *Ex parte Leonard* is not on point with respect to this claim, because the pending claim is an apparatus claim & *Leonard* deals with process claims. Claim 23 and Instance have the same structural features. The material worked upon, which the applicant is relying to distinguish their invention from Instance is not given significance in determining the patentability of the claim according to patent office practice. (See MPEP §§2114 & 2115.)

14. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

15. In response to applicant's argument that Instance is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Instance discloses a process and apparatus for controlling the placement of a component or label onto a web. Brandon discloses a process and apparatus for placing a component onto a web. The problems associated with placing an object onto a web, whether that object be a label or an absorbent component, are similar and the invention of Instance is reasonably pertinent to that particular problem with which the applicant was concerned. It would be within the purview of an artisan to look to Instance when confronted with the problem of how to control the placement of an object onto a web. Similarly, Weyenberg also deals with

Art Unit: 1734

registration and it would be within the purview of the artisan to look to Weyenberg to improve registration of the components onto the web.

16. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

17. In response to applicant's argument that the processes of Brandon & Instance on page 15 and 16, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Sue' followed by a stylized 'P' and a long horizontal line extending to the right.

Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
November 12, 2004